

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Kevin F. Bernier,
Todd M. Lynton And Richard A. Pineau**

Confirmation No.: **3893**

Serial No.: **10/023,245**

Group Art Unit: 2153

Filing Date: **December 18, 2001**

Examiner: **Yasin M. Barqadle**

For: **METHOD AND SYSTEM FOR GENERATING A PERMANENT RECORD
OF A SERVICE AT A REMOTE PRINTER**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANTS' REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellants submit this Reply in response to the Examiner's Answer dated April 29, 2008 in connection with the above-identified application. This reply is being filed within two months of said answer.

Claim 1 requires the use of a user chosen and designated remote printer. Claim 1 also requires that a remote service provider receiving center receive user provided data identifying and specifying the chosen remote printer and data regarding how to address and access the remote the remote printer over a data communication network. As argued at page 7 of the Appeal Brief:

Kemp discloses a remote printing service where a user sends a file to the remote printing service provider over a data network. It is the service provider who chooses the printer, not the user. As seen in paragraph [0057] and illustrated in Fig. 6B of Kemp, the user selects "Remote Printing To Service Providers" and the selected provider in turn prints the file at its print shop for later pick-up by or delivery to the user. See paragraph [0056].

The Office agrees that Kemp does not describe a “user chosen and designated specific remote printer.” Office's Answer, page 5. Rather, the Office relies upon Smith for this part of the claimed subject matter.

As argued at page 9 of the Appeal Brief, Smith only describes sending print information to one's own printer. As perhaps best seen in Fig. 7D and paragraph [0037] of Smith, the user of the Smith PDA may have options as to how to print, but all of the options lead back to the user's own printer 115.

It is believed that the Office has misapprehended the arguments in the Appeal Brief. Kemp describes a method where a user sends a file to a remote printing service. It is the printing service that ultimately decides what printer to use in completing the printing task. In contrast, Smith describes a process where a user may print through a number of pathways, but each pathway leads to the user's own printer. When Kemp and Smith are considered together, why would it have been obvious to modify Kemp on the basis of Smith? Kemp is clear that the remote printing service selects the printer, not the user, while Smith is equally clear that that the user uses his/her own printer 115. If one is selecting his/her own printer as in Smith, one would not have any need for a remote printing service as in Kemp.

The proposed combination lacks logic. The Office agrees that Kemp does not allow the user to select the printer to be used at the remote printing service. Thus, to propose that the user in Kemp be allowed to select the printer runs directly contrary to the disclosure of Kemp. As explained at page 10 of the Appeal Brief, this is evidence that Kemp teaches away from the Office's proposed modification. Where a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. *See Tec Air Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999).

The Office erroneously urges at pages 13-14 of the Office's Answer that Kemp and Smith “complement each other to arrive at the whole teaching of the Appellants['] invention.” The fact of the matter is that Kemp and Smith work against each other, not complement each other. Kemp describes a process where a user sending a file to a remote

printing service and the printing service selecting the printer while Smith describes a process for providing the user of a PDA options for accessing the user's own printer. Kemp does not allow the user to select the printer while the printer in Smith is self selected to be the user's own printer.

Finally, the Office's citation of *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) is noted. However, it is urged that the Office has used the disclosure of the present method and system as a template in order to combine Kemp and Smith. As noted in *McLaughlin*, this is a hallmark of impermissible hindsight.

For the reasons set forth above and in the Appeal Brief, reversal of the rejections is requested.

Date: June 30, 2008

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